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10/035,633

12/28/2001

Benjamin Niles Eldridge

P3C1-US

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06/19/2006

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EXAMINER

ARBES, CARL J

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,633

Applicant(s)

ELDRIDGE ET AL.

Examiner

C. J. Arbes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 375-428 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 404-426 is/are allowed.
- 6) ☒ Claim(s) 375-381, 399, 400, 402, 403, 427 and 428 is/are rejected.
- 7) ☒ Claim(s) 382-398 and 401 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>herein</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicants are noticed that the continuing data according to the Patent Office's records does not match or coincide with Applicants' representations in the instant Application. Applicants are requested to carefully review and correct, if necessary the ancestry of the instant Application so that the continuing data matches, tracks or correlates with those records of the ancestry held in the Patent Office or alternatively provide a showing and indicate why the Patent Office's records are incorrect.

An Office Action on the merits of Claims 375-428 now follows.

Claims 376-379 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. After reading and re-reading Applicants' lengthy and complex specification it is held that there is a lack of antecedent basis for the language... into a plurality of groupings (of contact structures) in claim 376 and until Applicants show the Office otherwise the Office rejects these claims as introducing new matter into the specification and claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 375, 380, 381, 400, 402, 403, 427 and 428 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan Pat 02-250327 by Hisaki hereinafter

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Hisaki (of Record). As applied to the rejected claims the document speaks for itself. For a further discussion of how the Office construes this document see remarks *infra*.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 376-379, 391 and 399 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisaki.

Hisaki teaches a method of making a contact structure comprising fabricating a plurality contact assemblies (Cf. Figs 1 and 2), providing a substrate comprising an array of electrical connections on the surface of electrical connections on the surface and attaching plurality of contact structures (such as 13) to the array of electrical connections (such as 12) As applied to claims 376-379, as understood, it is held that each time that a contact assembly is made up one must "pool" or select one or more of the groupings of contact structures prior to the attaching step and Hisaki teaches making a plurality of contact assemblies. Alternatively the limitations in these claims are held to be mere design choice since there is no particular purpose therefore nor any specific problem which is solved thereby. As applied to claim 391 It is held that the term "resilient" is so subjective in meaning and scope that substantially all materials can be held to be resilient i.e. have some amount of recovery given the proper conditions such as time, temperature, and force thereon. As applied to claim 399 the limitation of

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providing a probe card assembly is held not to narrow the method claim and therefore is given little or no patentable weight.

Claims 382-398 and 401 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 404-426 are held to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. J. Arbes whose telephone number is 571-272-4563. The examiner can normally be reached on M, T, R and F from 8 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Vo, can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. J. Arbes
Primary Examiner
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